

**Remarks**

Claim 1 is revised in response to the rejection under 35 U.S.C. § 112, second paragraph, and Claim 22 is revised to maintain a proper antecedent basis with its parent Claim 10. Claims 1-4, 7-13, 15, and 18-24 remain in the application, with no claim previously allowed.

The formal rejection of Claims 10-13, 15, 18-22, and 24 is noted. In response the Applicant is amending Claim 10 to recite --a relational database--, consistent with the Examiner's stated interpretation of that claim. In view of that change in Claim 10, the preamble of Claim 22 is revised to mention --the relational database-- of parent Claim 10. These amendments are submitted to overcome the rejection based on 35 U.S.C. § 112, second paragraph.

Claims 1, 4, 7, 8, 10-13, 15, 18, 19, and 21-24 are rejected as unpatentable over newly-cited *Munsil* (US 5,761,650). The Applicant respectfully traverses this rejection.

The Applicant acknowledges with appreciation the Examiner's detailed discussion of *Munsil* in relation to the claims under rejection. The discussion notes that *Munsil* does not specifically teach positioning the non-billing information between a customer identifier located at the beginning of the communication and a billing amount located at the end of the communication. However, the rejection asserts that the Applicant's specific claimed positioning of the non-billing information —between the customer identifier at the beginning and a billing amount at the end of the communication— is not a critical feature of the present invention, and purports to find a clear indication in the specification that the specific placement of non-billing information "holds no functional importance nor does it produce an unexpected or distinct result". The Applicant traverses that interpretation of the specification and the Examiner's conclusion as to obviousness.

Considering first the Applicant's disclosure of specific location for the non-billing information, the Applicant respectfully points out that Figures 4 and 5 depict the only disclosed embodiments of the present invention. In those embodiments, non-billing information is positioned between the customer identifier located at the beginning of the communication and a billing amount located at the end of that communication. The Applicant respectfully submits that disclosing embodiments sharing a novel element of the claimed invention does not support the Examiner's inference that this novel element (the specific positioning of non-billing information between a customer identifier at the beginning of the communication and a billing amount at the end of that communication) holds no functional importance nor produces no unexpected or distinct result.

The Examiner also finds the novel limitation in Claim 1, namely, positioning the non-billing information between a customer identifier at the beginning of the communication and a billing amount at the end of the communication, to be "an aesthetic design" choice and, therefore, obvious to one of ordinary skill. Furthermore, citing *In re Seid*, 73 USPQ 431, and MPEP 2144.04 that matter relating only to ornamentation can not be relied upon to patentably distinguish a claimed invention from the prior art, the Examiner appears to assert that the above-mentioned novel element of Claim 1 is of no patentable consequence, whether or not that element would have been obvious to one of ordinary skill. The Applicant traverses those positions taken by the Examiner.

Considering *In re Seid*, the Court there found "no mechanical function whatever" between the shape and the arrangement of a human figure, and the neck of a bottle supporting that figure in an apparatus claim. The particular shape and arrangement of the human figure related to ornamentation only and, therefore, could not be relied on to distinguish over the art.

That case is inapposite to the Applicant's invention. Claim 1, first of all, is a method claim, not an article or apparatus claim as in *Seid*. More significantly, Claim 1 defines a specific locational interrelation between the positioning of the non-billing information, and the customer identifier located at the beginning of the communication and the billing amount located at the end of the communication. This specific interrelation between placement of the recited functional elements comprises the overall method defined by Claim 1. The Applicant submits that the specific elements of the "combining..." functions are entitled to patentable consideration and may not properly be disregarded as relating to ornamentation, absent an express and unambiguous statement otherwise by the Applicant.

The later cases cited in MPEP 2144 do not appear to follow *In re Seid*, at least where shape is material as resulting in a product distinct from the reference. The presently-claimed method creates a novel communication with customers by combining non-billing information between customer identification at the beginning and a billing amount located at the end of the communication. *Munsil* fails to disclose or suggest that specific method for communicating with customers, and nothing in that reference would have suggested to one of ordinary skill to modify the teachings of *Munsil* to include that specific placement as recited in Claim 1. The motivation to modify *Munsil* comes only from the present Applicant, not from anything found in that reference. Accordingly, Claim 1 and the claims depending from are patentable over that reference.

The foregoing arguments apply as well to system Claim 10. The elements comprising that system must create a customized communication wherein the non-billing information is located between a customer identifier at the beginning of the communication and a billing amount located at the end of the communication.

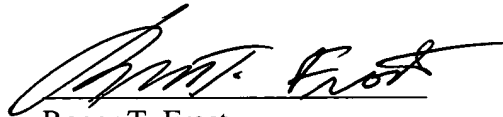
*Munsil* fails to teach or suggest that element. One of ordinary skill cannot find in that reference or the other art of record any such teaching. Accordingly, the Applicant respectfully submits that Claim 10 becomes "obvious" only after considering the present disclosure. For that reason, Claim 10 and the claims depending therefrom are properly patentable over *Munsil*.

The foregoing is submitted as a complete response to the Office Action identified above. The Applicant submits that the application is in condition for allowance and solicits a notice to that effect.

Respectfully submitted,

MERCHANT & GOULD

Date: June 1, 2005



Roger T. Frost  
Reg. No. 22,176

Merchant & Gould  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
Telephone: 404.954.5100

